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Paper No. 11

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NO. 100
ROOSEVELT ROAD, SECTION 2
TAIPEI, TAIWAN
R.O.C.

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DEC 19 2003

OFFICE OF PETITIONS

In re Application of :
Lee et al. :
Application No. 10/064,382 : **DECISION ON PETITION**
Filed: July 9, 2002 :
Attorney Docket No. 9048-US-PA :

This is a decision on the petition under 37 CFR 1.137(a), filed November 28, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)" or "Renewed Petition under 37 C.F.R. §1.137(b)," as appropriate.

The above-identified application became abandoned for failure to timely pay the required issue fee within the statutory period of three (3) months from the mailing date, February 7, 2003, of the Notice of Allowance and Fee Due. No extensions of time are permitted for transmitting issue fees. Accordingly, the above-identified application became abandoned on May 8, 2003. A Notice of Abandonment was mailed July 17, 2003. By decision mailed October 1, 2003, a prior petition to withdraw the holding of abandonment filed August 5, 2003 was dismissed.

Petitioner contends that the Issue Fee was mailed to the USPTO via the United Parcel Service (UPS) on April 29, 2003 and received on time by the USPTO prior to the due date of "May 12, 2003." In support thereof, petitioner submits a copy of the UPS delivery notification, which petitioner states indicates that the parcel was delivered to the USPTO at 9:34 am on April 30, 2003, and signed for by Mr. Brown. Petitioner further states that their prepaid return postcard indicated that the parcel was not directed to the proper office until May 22, 2003. As a result, petitioner states the issue fee was not charged on time. Petitioner further states that the delay of the parcel to the appropriate office was possibly due to the address change of the PTO during that period of time, which was between April and May. Petitioner states that the delay should be considered unavoidable since diligent effort was made to duly pay the issue fee.

STATUTES, RULES AND REGULATIONS

35 U.S.C. § 151, provides that the Commissioner may accept the delayed payment of an Issue Fee if the delay in payment is shown to the satisfaction of the Commissioner to have been unavoidable. A grantable petition to revive an unavoidably abandoned application under 37 C.F.R. §1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR §1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d). Item (3) is at issue in this case¹.

The burden of showing the cause of the delay is on the person seeking to revive the application. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). This burden includes establishing that the entire delay from the due date for the reply until the filing of a grantable petition was unavoidable. Haines v. Quigg, 673 F.Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (*quoting Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

¹ The issue fee, resubmitted on petition, satisfies item (1). (The Notice of Allowability did not set for a requirement for drawings). The petition included payment of the petition fee. As this utility application was filed after June 8, 1995, item (4) is not required.

ANALYSIS

Petitioner's arguments and evidence have been considered, but not found adequate to show "unavoidable" delay within the meaning of § 1.137(a).

The date stamped on the postcard receipt is the date that the Office considers the correspondence received in the Office. See MPEP 503. As petitioner's postcard receipt is date stamped May 22, 2003, the evidence supports a conclusion that the issue fee transmittal was received in the Office on May 22, 2003, after the end of the statutory period for paying the issue fee.

The UPS delivery notification is not persuasive evidence of timely filing or of diligence. The rules provide for the timely receipt of correspondence being evidenced by a date-stamped postcard receipt, not by a record from the deliverer of the date someone signed for the package. In addition, the delivery notification submitted to evidence timely receipt by the Office states that the shipment was sent to:

UNITED STATES
2221 JEFF DAVIS HWY STE 1103
ARLINGTON VA 22202

The undersigned is not aware of this being the correspondence address for submitting payment of the Issue Fee or otherwise communicating with the Office. Nor is the undersigned aware of this being the building address for any USPTO Office building.

Furthermore, the referenced OG Notice directed applicants to address mail to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolator, etc.) as follows:

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

The proper addresses for sending correspondence to the Office were readily available to applicant. The failure to properly address correspondence is not found "unavoidable" within the meaning of § 1.137(a). Even if the correspondence were properly addressed, the evidence does not show that the response was, as alleged, timely received in the Office.

Accordingly, it is concluded that petitioner has not met his burden of showing that the delay was unavoidable.

CONCLUSION

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 C.F.R. §1.137(b) on the basis of unintentional delay. A grantable petition under

§ 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 C.F.R. §1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to § 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 ATTN: NANCY JOHNSON
 SENIOR PETITIONS ATTORNEY

By hand: CUSTOMER SERVICE WINDOW
 2011 South Clark Place
 Crystal Plaza Two Lobby
 Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.



Nancy Johnson
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